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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,170	08/17/2001	Federico G. Jaekel	P 280447 701750-Dkt 419	1450

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EXAMINER

LEE, EDMUND H

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/931,170

Applicant(s)

JAEKEL, FEDERICO G.

Examiner

EDMUND H LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a method of making an exterior body panel, classified in class 264, subclass 510.
- II. Claims 9-11, drawn to an exterior body panel, classified in class 442, subclass 59+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as injection molding each of the plastic layers onto a preformed decorative material.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation between Examiner Lynda Salvatore and Thomas Hilliard on 12/3/02 a provisional election was made with oral traverse to prosecute the invention of group I, claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-11 are withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "depositing one side of the decorative material" (cl 5, ln 3) is indefinite because it is idiomatically incorrect. It appears the word --on-- should be inserted after "depositing".

Clarification and/or correction is required.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellison (USPN 6399193). Ellison teaches the claimed process as evident by col 1, ln 20-25 and col 4, ln 17-col 7, ln 2.

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellison (USPN 6399193) in view of Mueller (USPN 5230906). In regard to claim 5, Ellison teaches the basic claimed process including a method of making vacuum formed exterior body panels (col 1, ln 20-25 and col 4, ln 17-col 7, ln 2); providing a layer of decorative material (col 1, ln 20-25 and col 4, ln 17-col 7, ln 2); depositing on one side of the decorative material a resin which when cured forms a plastic layer that is substantially transparent (col 1, ln 20-25 and col 4, ln 17-col 7, ln 2); depositing on an opposite side of the decorative material a resin which when cured forms a plastic layer (col 1, ln 20-25 and col 4, ln 17-col 7, ln 2); heating the decorative material and the plastic layers (col 1, ln 20-25 and col 4, ln 17-col 7, ln 2); pressing the decorative material, the top layer and the bottom layer in a vacuum mold to form a laminate (col 1, ln 20-25 and col 4, ln 17-col 7, ln 2); and cooling the pressed laminate (col 1, ln 20-25 and col 4, ln 17-col 7, ln 2). However, Ellison does not teach using a mixture of epoxy and resin in the plastic layers. Mueller teaches vacuum molding a car body part (col 1, lns 15-21; abstract; figs 1-4); and coating the top and bottom surfaces of a fibrous web/decorative material with a mixture of epoxy and resin (col 3, lns 39-41). Ellison and Mueller are combinable because they are analogous with respect to forming a car body

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part. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the mixture of epoxy and resin as taught by Mueller as the depositing material of Ellison in order to form durable parts from readily-available materials. In regard to claims 6-8, Ellison teaches using a flexible decorative material (col 1, ln 20-25 and col 4, ln 17-col 7, ln 2); using a vacuum mold comprising an upper die and a lower die (col 1, ln 20-25 and col 4, ln 17-col 7, ln 2); and removing air from the vacuum mold in forming the molded laminate (col 1, ln 20-25 and col 4, ln 17-col 7, ln 2).

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adesko et al (USPN 5000809) teach the state of the art. Ellison (USPN 5985079) teaches the state of the art. Both Susa et al (USPN 5760122) and Matsui et al (USPN 5601917) teach the well-known existence of paint films having a mixture of epoxy and resin thereon.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H LEE whose telephone number is 703.305.4019. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD CRISPINO can be reached on 703.308.3853. The fax phone numbers for the organization where this application or proceeding is assigned are

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703.305.7718 for regular communications and 703.305.3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.

  
EDMUND H LEE  
Examiner  
Art Unit 1732

6/2/03

EHL  
June 2, 2003